

REMARKS

Upon entry of the present amendment, claims 1-24 and 31 will be pending in the above-referenced patent application and are currently under examination. Claims 1, 21 and 31 have been amended. Support for the amendments can be found throughout the specification. Claims 25-30 have been canceled. Reconsideration of the application is respectfully requested.

The claims are rejected in various combinations under 35 USC § 112, first and second paragraphs, and 35 USC § 102(b). Each of these rejections is addressed below in the order set forth by the Examiner.

I. 35 USC § 112, 2d REJECTIONS

Claims 1-31 have been rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully traverse the rejection in view of the comments below.

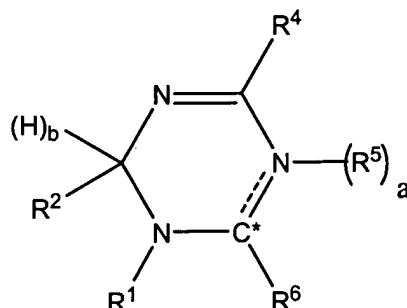
The test for indefiniteness is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity” (MPEP § 2173.02). This analysis does not occur in a vacuum, but rather in view of the following factors: (1) the content of the particular application disclosure; (2) the teachings of the prior art; and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In addition, “the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope” (MPEP § 2173.02).

A. Radical R² is allegedly indefinite

The Examiner alleges that the recitation of R² being either (=O) or NR⁷R⁸ is unclear as the ring carbon to which R² is attached also has a hydrogen attached, so R² must be monovalent. The Examiner also notes that if R² is divalent, then the valence of the nitrogen in the NR⁷R⁸ group will be greater than three “and there is recitation as to what else is appended to

the nitrogen to make it pentavalent.” Applicants respectfully traverse the rejection in view of the comments below.

Applicants note that claim 1 has been amended to more clearly define the invention. Formula I has been amended to the following:



where a hydrogen has been added to the ring carbon to which R² is attached. Additional amendments to R² provide that the hydrogen attached to the R² ring carbon is only present when R² is NR⁷R⁸ (b=1): R² is a member selected from (=O) and NR⁷R⁸, **such that when R² is (=O), b is 0, and when R² is NR⁷R⁸, b is 1** (emphasis added). When R² is (=O), the hydrogen is not present (b=0). Support for the amendments to Formula I and R² can be found in claim 1 as filed, as well as in Schemes 1-7 (pp. 21-25) and the compounds of Example 1.

In view of the amendments to Formula I and R², there is no lack of clarity as to the presence of hydrogen on the ring carbon to which R² is attached. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

B. The proviso of claim 1 is allegedly indefinite

The Examiner has alleged that the proviso in claim 1 renders claims 1-31 indefinite as none of the radicals are carbamate or urea. Applicants respectfully traverse the rejection in view of the comments below.

The proviso of claim 1 states the following: wherein at least one member selected from R³, R⁵, R⁷, and R⁸, alone or **together with the atom to which it is covalently bonded**, is selected from carbamate and urea linkers (emphasis added). Claim 9 provides that R³, R⁵, R⁷, and R⁸ can be -C(O)OR¹⁴, and claim 10 provides that R³, R⁵, R⁷, and R⁸ can be -C(O)NR¹⁵. Thus, when R⁸ is -C(O)OR¹⁴, so that when R⁴ is NR⁷R⁸ and R⁷ is H, R⁴ becomes -NHC(O)OR¹⁴,

a carbamate. Alternatively, R^8 can be $-C(O)NR^{15}$ (see claim 10) so that when R^4 is NR^7R^8 and R^7 is H, R^4 becomes $-NHC(O)NR^{15}$, a urea. Thus, when R^3 , R^5 , R^7 , and R^8 are considered in combination "with the atom to which they are covalently bonded," they can form a urea or carbamate. See also Schemes 5-7 (pp. 23-25), paragraph 72, and compounds of Example 1.

As R^3 , R^5 , R^7 , and R^8 can form a carbamate or urea either alone or in combination with the atom to which they are covalently bonded, it is clear what is intended, and the proviso is applicable. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

C. Claim 31 is allegedly indefinite

The Examiner alleges that claim 31 is indefinite as reciting a compound according to Formula I, but has no such structural formula. Applicants respectfully traverse the rejection in view of the comments below.

Applicants note that claim 31 has been amended to recite a compound of claim 1. Thus, the compounds of claim 1, including those of Formula I, are incorporated into claim 31. Newly amended claim 31 properly incorporates the compounds of claim 1, and is not indefinite. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

II. 35 USC § 112, 1st ENABLEMENT REJECTION OF CLAIMS 21-30

Claims 21-30 have been rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection.

The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable (*Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916)) such that "the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention" (MPEP § 2164.01).

Applicants note that claims 25-30 have been canceled and that claim 21 has been amended to recite simply an HIV viral disease. Thus, claims 21-24 are enabled, as the Examiner

noted in the current Office Action that the specification was enabling for HIV viral infections (page 3). Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

III. 35 USC § 102(b) REJECTION OF CLAIMS 1, 2, 6, 7 AND 21

Claims 1, 2, 6, 7 and 21 have been rejected under 35 USC § 102(b) as allegedly being anticipated in view of U.S. Patent No. 4,140,850 ("Wierenga"). Applicants respectfully traverse the rejections in view of the comments below.

A claim is considered to be anticipated under 35 USC § 102(b) only if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." In order for a claim to be anticipated by a reference, the reference must teach every element of the claim (MPEP § 2131):

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As discussed in detail below, the presently claimed invention is not anticipated in view of any of the cited references as all the references fail to teach every element set forth in the claims of the instant invention.

The Examiner alleges that Wierenga teaches 2,2'-anhydrotriazine nucleosides for treating herpes virus, noting that when R^2 is (=O), R^4 and R^6 is OR^3 and R^3 is H, the compounds of Wierenga are encompassed by the claims of the instant invention. Applicants respectfully traverse the rejection in view of the comments below.

Applicants note that claim 1 has been amended to remove " OR^3 " from R^6 , and has been replaced with "substituted or unsubstituted O-alkyl" which is OR^3 where the R^3 is substituted or unsubstituted alkyl. This amendment finds support in the claims as filed (see R^3), and in the specification at paragraph 18 which defines "alkoxy" to "refer to those alkyl groups attached to the remainder of the molecule via an oxygen atom."

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As R^4 of the newly amended claims cannot be OR^3 where R^3 is H, the compounds of Wierenga are not embraced by newly amended claim 1, or any claim of the instant application. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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